

REMARKS

Claims 13-24 are pending in the present application. No claims have been added or deleted. Support for the amendments to the claims can be found in the specification, for example, at paragraph 0023 and 0032. Accordingly, Applicants respectfully submit that no new matter has been added.

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, Claims 13-18, 20-22 and 24 are specifically rejected under 35 U.S.C. § 103(a) as being unpatentable over Takazawa (USP 4,774,105) in view of Kotera (USP 4,340,519) and, presumably, Creps (USP 4,358,887), with claims 19 and 23 apparently being rejected in view of these references combined with general knowledge available in the art. Applicants respectfully traverse the rejection as to the claims above, and submit that these claims are allowable for at least the following reasons.

Applicants rely on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 cannot be met with the references noted in the Office Action in view of the present claim set.

The Cited References Do Not Suggest All Claim Recitations

Even if the first requirement of MPEP § 2143 can be satisfied with the cited references the Office Action (which it cannot, as explained below), the cited references still do not meet the third requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Claim 13 has been amended to affirmatively recite that the coated steel wire has a bright looking surface. Specifically, the claim now recites that the covered steel core is drawn to obtain a bright looking surface, and that the steel wire has, immediately on its intermediate coating, a polymer. Thus, the steel core is a drawn steel core with a bright looking surface, a surface on which a polymer is immediately attached.

The Office Action cites Takazawa as teaching “a metal article comprising a core covered with an intermediate coating layer and a” polyester. However, Takazawa is completely silent in regard to teaching a bright surface on which a polymer is immediately attached. The Office Action correctly points out that in Takazawa, a polyester layer covers a zinc layer. Assuming *arguendo* that this polyester layer is immediately attached to the zinc layer, Takazawa is still completely silent in regard to a polyester layer immediately on a bright looking surface.

The Office Action states that Creps teaches “a coated steel substrate that is covered with an intermediate layer and immediately thereupon with” polyester. However, it is respectfully submitted that this is not the case. The Office Action correctly identifies Creps as teaching that polyester is placed over an intermediate layer. However, the polyester is not “immediately upon said intermediate coating,” where the intermediate coating is a bright looking surface. Creps teaches that a chromate coating is deposited between the intermediate galvanized coating and the plastic coating (Col. 3, lines 29-32). This is not a mere design issue, as Creps states that a step in the process

is to deposit a chromate compound on the shiny galvanized coating to retain its brightness. In the final treatment, a clear

plastic coating is applied from the group consisting of polyester resins, vinyl alkyds and fluorocarbons, generally from 0.002" to 0.006.

(Creps, col. 5, lines 42-47, emphasis added.) Thus, in Creps, a chromate compound is interposed between the intermediate layer and the polyester. As a result, Creps does not disclose the just claimed structure, and in fact teaches away from the present invention. If Creps and Takazawa are combined, the polyester layer would not be immediately disposed on the bright looking surface.

Kotera is limited in its teachings to various types of polyester and the colors associated with those types of polyesters. Thus, it does not remedy the deficiencies of Creps and Takazawa.

Regarding claim 20, the element of "polyester is immediately disposed on said intermediate coating layer" is not taught by Takazawa, Creps or Kotera for the reasons just mentioned.

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Claim 13 has also been amended to recite that the covered steel core is drawn to obtain a bright looking surface. That is, the covered steel core is a drawn steel core. None of the cited references teach a *drawn* wire. Takazawa teaches a "squeezing means" 4 of the zinc bath 3. However, these are not drawing dies. At the point 4 in Takazawa, the zinc is still in the fluid phase and thus a deformation drawing by means of drawing dies cannot take place at this point. (The squeezing means 4 functions merely as a wiping means for the zing coating.)

Creps and Kotera are likewise silent in regard to drawing. In rejecting claim 23, the Office Action appears to equate the use of pullout rolls 30 and 31 of Creps for straightening to drawing. However, the pipe of Creps is not drawn, as the rolls are merely for straightening the pipe. Thus, claim 13 is allowable for this reason as well.

Claim 20, which has also been amended to recite the drawing recitation, is likewise allowable.

In sum, even if the first requirement of MPEP § 2143 can be satisfied, the third requirement of MPEP § 2143 cannot be satisfied by the references cited in the Office Action, since the cited references does not teach each and every element of the present invention. Thus, the present independent claims are allowable for the above reasons and the dependent claims are allowable for at least the reason that they depend from allowed claims.

Lack of Suggestion or Motivation to Modify or Combine the References

Applicants respectfully submit that the PTO has not carried its initial burden of pointing to some suggestion or motivation from within the prior art itself to combine the cited references, which are from different fields of endeavor (manufacturing metal strips and pipes versus steel wires). Therefore, it is unlikely that a person skilled in the art would have been motivated to combine Creps with Takazawa in the manner alleged. Moreover, even though Takazawa is directed to making a galvanized wire, Takazawa is silent as to any coating steps other than hot dipping (galvanizing) the wire in molten zinc. Thus, even if the references were combined, there would be no motivation to modify Creps, which would include a chromate coating, and produce Applicants' claimed structure and method.

Conclusion

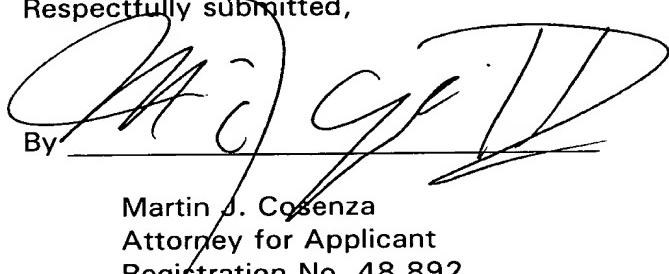
Applicants respectfully submit that the present application is in consideration for allowance.

If applicants have not accounted for any fees required by this Amendment, the Commissioner is hereby authorized to charge to our Deposit Account No. 19-0741. If applicants have not accounted for a required extension of time under 37 C.F.R. § 1.136, that extension is requested and the corresponding fee should be charged to our Deposit Account.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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